

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed March 18, 2004. Claims 4-45 are pending in the current application.

Rejection of Claims 4-45 Under 35 U.S.C. §112

Claims 4-45 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection as follows.

It is respectfully submitted that the Examiner appears to misunderstand the invention and has applied an incorrect standard under §112, second paragraph. Embodiments of the invention relate to a system where an individual is able to obtain information contained on his or her base computer when the individual is away from the base computer. The system employs a remote access server for communicating the information from the base computer to a remote access device, which, in embodiments, may be operated by the individual.

In support of the §112, second paragraph, rejection, the Examiner stated at page 2 of the Office action:

It does not make sense for the individual who owned the base device to ask the remote server to obtain the data from his/her own base device.

Applicants respectfully disagree with this ground of the rejection for two reasons. First, as indicated above, it **does** make sense for the individual who owned the base device to ask the remote server to obtain the data from his/her own base device if the individual is remotely located from the base device and does not have direct access to the base device. Second, even assuming a scenario where an individual did have access to the base device, but chooses to obtain data from a remote server nonetheless, the claim would still not violate the requirements of §112, second paragraph. The Examiner appears to indicate that there would be no reason, and it would be an unnecessary waste of time, for an individual to obtain data from a remote server when the individual could simply obtain the data from the base device directly. As best understood, the Examiner is stating that because the **practice of the invention** does not make sense, then the claim itself violates §112, second paragraph. However, whether or not the

practice of an invention is sensible and whether or not the practice of an invention would result in a waste of time, is irrelevant to whether the claim itself is clear and concise as required by §112, second paragraph.

The purpose of §112, second paragraph, is to apprise the public of the metes and bounds of a patent claim. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). All §112, second paragraph, requires is that “one skilled in the art would understand the bounds of the claim when read in light of the specification. *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). The claims in the present application accomplish this. Whether the practice of an invention makes practical sense is irrelevant to this analysis.

The Examiner went on to say that “the amended claim 4, 17 and 29 do not match with the drawing 1, in which the base device 15 is not owned/operated and/or controlled by the individual 16a, 16b or 16c.” Applicants respectfully submit that this is incorrect. Nowhere does the application indicate that the base device 15 may not be owned/operated and/or controlled by the individual 16a, 16b or 16c. In fact, the application states at page 5, line 19 through page 6, line 2:

The MRS [map response subsystem] when operating in conjunction with a remote access system provides access to data resident on a base device. Under this arrangement the user is able to obtain location and driving directions for data resident on a base device. **For example, the base device may be a user’s home computer.** Under this scenario, a user accessing a conventional remote access device, such as a cell phone, is able to obtain location and driving directions, not only for locations which the user may input, but for locations resident on the home computer, such as the addresses located on the user’s address book stored on the home computer. (Emphasis added).

Thus, it is clear that the base device 15 may be owned/operated and/or controlled by the individual.

Based on the above, it is respectfully requested that the rejection on §112, second paragraph, grounds be withdrawn. If the Examiner maintains the rejection on these grounds, it is respectfully requested that the Examiner make a specific showing as to why one skilled in the art would not understand the bounds of the claim when read in light of the specification.

Rejection of Claims 4-37, 39, 40, 42, 43 and 45 Under 35 U.S.C. § 103(a)

Claims 4-37, 39, 40, 42, 43 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,260 to Musk, et al. ("*Musk*") in view of U.S. Patent No. 5,543,789 to Behr, et al. ("*Behr*"). Applicants respectfully traverse the rejection as follows.

Musk, et al. teaches a network accessible service that integrates both a business directory and a map database. Col. 1, lines. 32-34. User computer system 1 interfaces over Internet link 14 to software and database central server system 16. Col. 2, lines. 16-19, Fig. 1. A user initiates a search request to server 16. Server 16 performs the search and generates a map that is sent to the user. Col. 2, lines. 58-62, Fig. 3.

Behr, et al. teaches a method of providing route guidance information to a mobile unit in response to a request from the mobile unit. Col. 2, lines. 50-52. System 10 includes unit 12 and a plurality of remote units arranged to communicate with unit 12. Col. 5, line. 66 – col. 6, line. 2, Fig. 1. Third party integrator 80 in system 10 provides additional data for responding to queries from a mobile unit. The additional data is preferably received from other information providers, illustrated in Figure 1 as functional block 82. The additional data may be supplied from external sources to unit 12 via any known data communication network. Col. 9, lines. 47-55.

Each of the rejected claims recites a method for servicing requests generated by an individual for geographic information including the steps of receiving a request at a remote access server from a remote access device, wherein:

said request calls for said remote access server to obtain data from a base device owned, operated and/or controlled by the individual, and

said base device is operatively coupled for communication with said remote access server via a network.

None of the cited references, taken alone or in combination with each other, teaches or suggests these expressly claimed limitations.

Musk, et al. provides no teaching or suggestion that the user's request calls for the server to obtain data from a base device as recited that is operatively coupled for communication with the server via a network, as required by claims 4, 17, and 29. The Examiner has acknowledged this shortcoming in *Musk, et al.* See Office Action mailed June 10, 2003, p. 3.

Nor does *Behr, at al.* provide a teaching or suggestion of the above-cited limitations. *Behr, at al.* teaches that base unit 12 may obtain information from a functional block 82, which may be “on-line yellow pages information or traffic advisory information.” (Col. 9, lines 47-48). However, there is no teaching or suggestion of a server capable of accessing a base device which is owned, operated and/or controlled by the individual requesting the geographic information as recited in the claims. In fact, it would be clear to one skilled in the art that the functional block 82 is not “owned, operated and/or controlled by the individual requesting the geographic information” as expressly called for in the claims. The websites of functional block 82 of *Behr* are public websites. The Examiner has stated at page 3, paragraph 9, that the “yellow pages information database or traffic advisory information database is owned by an individual.” Applicants respectfully submit that there is no such teaching or suggestion in the reference – there is no indication who owns the databases. However, in any event, *Behr* discloses that functional block 82 is an “on-line yellow pages information or traffic advisory information.” It is not a base device under the ownership, operation or control of the individual making the request, as specifically called for in the claims.

Applicants addressed these same rejections in the previous Response filed December 31, 2003. In the current Office action, the Examiner has not made any indication why applicants’ previous remarks were not found persuasive, and has not explained where the above discussed limitations are found in the combination of the references. In the current Office action, the Examiner stated only that:

Applicant’s arguments filed on December 31, 2003 have been fully considered. However, upon the amended claims, **new rejection has been set forth as above.** (Emphasis added).

However, the prior art rejection made is not a new rejection. It is exactly the same rejection as the previous rejection. Applicants addressed that rejection in the December 31, 2003 Response, and again address it here. If the Examiner maintains the rejection, it is respectfully requested that the Examiner specifically point out where the cited references teach the limitations of a server capable of accessing a base device which is owned, operated and/or controlled by the individual requesting the geographic information. In this regard, applicants note that all claim limitations are significant, and must be given weight and effect vis-à-vis the patentability of the

claims. *Application of Saether*, 492 F.2d 849, 852 (C.C.P.A. 1974). If even a single claim limitation is not taught or suggested by the prior art, then that claim cannot be obvious over the prior art. *Application of Glass*, 472 F.2d 1388, 1392 (C.C.P.A. 1973). Therefore, unless the Examiner is able to show where the above-cited limitations from independent Claims 4, 17 and 29 are found in the cited references, taken alone or in combination with each other, it is respectfully submitted that Claims 4, 17 and 29 must be considered patentable over the cited references.

Claims 5-16 and 37-39 depend ultimately from claim 4 and include all the limitations of claim 4 — making claims 5-16 and 37-39 patentable for at least the same reasons as set forth above for claim 4.

Claims 18-28 and 40-42 depend ultimately from claim 17 and include all the limitations of claim 17 — making claims 18-28 and 40-42 patentable for at least the same reasons as set forth above for claim 17.

It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Based on the above amendments and these remarks, reconsideration of Claims 4-45 is respectfully requested.

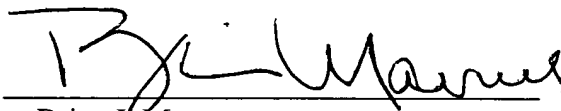
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: July 19, 2004

By:

A handwritten signature in black ink, appearing to read "Brian I. Marcus", written over a horizontal line.

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